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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,071	08/23/2000	Patrick Englebienne	REDL-002	2670

7590 12/18/2001

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EXAMINER

NOLAN, PATRICK J

ART UNIT PAPER NUMBER

1644

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DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/645,071

Applicant(s)  
Englebienne et al.

Examiner  
Patrick J. Nolan

Art Unit  
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-25 are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### Part III DETAILED ACTION

1. Claims 1-25 are pending.

#### Restriction/Election

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-10, drawn to a method of diagnosing, classified in class 435, subclass 7.1.

Group II. Claims 11-13 and 17-18, drawn to a method of treating with an RNase L cleavage antagonist, classified in class 424, subclass 184.1.

Group III. Claims 11-12, 14 and 17-18, drawn to a method of treating with an agent which enhances RNase L expression, classified in class 424, subclass 184.1.

Group IV. Claims 11-12, 15 and 17-18, drawn to a method of treating with agent which enhances 2 5 A production, classified in class 424, subclass 184.1.

Group V. Claims 11-12 and 16-18, drawn to a method of treating with a RNase L fragment antagonist, classified in class 424, subclass 184.1.

Group VI. Claims 19-23, drawn to a in vitro method to test a compounds RNase L cleavage inhibitory activity, classified in class 435 subclass 4.

Group VII. 24-25, Claims 24-25, drawn to a in vitro method to test a compounds apoptosis inducing activity, classified in class 435 subclass 4.

The inventions are distinct, each from the other because of the following reasons:

3. Groups I-VII are unique methods. They differ with respect to ingredients and method steps. A method of diagnosing is patentably distinct from methods of treating or in vitro testing methods and treating with different compounds represent patentably distinct subject matter.

4. Because a search of any of these seven distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

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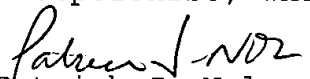
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Tuesday through Friday from 9:00 am to 5:30 pm.

9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

  
Patrick J. Nolan, Ph.D.  
Primary Examiner, Group 1640  
December 16, 2001